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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,408	03/27/2000	KLAUS MALER	112740-421	3860

29177 7590 07/14/2003

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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 07/14/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

21

Office Action Summary

Application No.
09/509,408

Applicant(s)
Klaus Maler

Examiner
Naghmeh Mehrpour

Art Unit
2683



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 9, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2686

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 7-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ault et al.(US Patent 5,754,542) in view of Nishida (US Patent Number 5,995,828).

Regarding **Claim 7**, Ault teaches a communication terminal apparatus for wireless communication with a selected base station of one of at least two communication systems (column 1 lines 39-46), the communication terminal apparatus being logged on as ready to receive the selected base station, the communication terminal apparatus comprising:

recognition means for recognizing one of the at least two communication systems, the recognized communication system having the selected base station (Column 2 lines 5-9), and

control means **configured to allocate** a network address to the recognized communication system under which the communication terminal apparatus can currently be reached and **communicating** control information via the selected base station to a control network address **stored in a memory (col 4 lines 9-24) of the communication apparatus** (column 3 lines 64-67, column 4 lines 1-15).

Art Unit: 2686

Ault fails to teach wherein the network address communicated to the control network address stored in memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached. However Nishida teaches wherein the network address communicated to the control network address stored in memory (col 4 lines 60-65) is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached (column 7 lines 20-44), communication system move from one network to another network, for identifying each network, uses the network address. Nishida system having the first network address for receiving telephone calls from the first base station in the first communication zone and a second network address different from the first address network for receiving telephone calls from the second base station in the second communication zone (column 11 lines 30-45). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to provide above teaching of Nishida to Ault, in order to provide a more feasible system with less cost by reducing roaming charges.

Regarding **claim 8**, Ault teaches a communication terminal apparatus for wireless communication with a selected base station of one of at least two communication systems (Column 1 lines 39-46), the communication terminal apparatus being logged on as ready to receive the selected base station, the communication terminal apparatus comprising:

Art Unit: 2686

recognition means for recognizing one of the at least two communication systems, the recognized communication system having the selected base station (Column 2 lines 5-9), and control means **configured to allocate** a network address to the recognized communication system under which the communication terminal apparatus can currently be reached and **communicating** control information via the selected base station to a control network address **stored in a memory of the communication apparatus (column 3 lines 64-67, column 4 lines 1-15)**, for influencing an activation/deactivation condition related to another communication system not having the selected base station (column 4 lines 24-31, column 5 lines 5-39). Ault fails to teach wherein the network address communicated to the control network address stored in memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached. However Nishida teaches a method wherein a communication system move from one network to another network, for identifying each network, uses the network address. Nishida system having the first network address for receiving telephone calls from the first base station in the first communication zone and a second network address different from the first address network for receiving telephone calls from the second base station in the second communication zone (column 11 lines 30-45). It is clear that, Nishida teaches an apparatus (portable handy phone, see figure 1) wherein the network address communicated to the control network address (column 7 lines 20-44) stored in memory (col 4 lines 60-65) is used for assisting in handling a call intended for the communication terminal

Art Unit: 2686

apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached (column 4 lines 44-60). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to provide above teaching of Nishida to Ault, in order to provide a more feasible system with less cost by reducing roaming charges.

Regarding **Claims 9-10**, Ault teaches a communication terminal apparatus wherein the control information activates a call redirection relating to a subscriber address under which the communication terminal apparatus can be reached via another communication system not having the selected base station, given corresponding readiness to receive the another communication system by the communication terminal apparatus (column 2 lines 14-25).

Regarding **Claim 11**, Ault teaches a communication terminal apparatus wherein the memory stores a control network address of a mobility server (column 4 lines 15-18).

Regarding **Claim 12**, Ault teaches a communication terminal apparatus wherein the memory stores a plurality of control network addresses of a plurality of communication systems, and the communication terminal apparatus further comprising: selection means for selecting at least one control network address of another communication system not having the selected base station (column 2 lines 15-25).

Response to Arguments

3. Applicant's arguments filed 4/09/03 have been fully considered but they are not persuasive.

Art Unit: 2686

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e the user preferences stored in a nonvolatile memory of Ault are not comparable with the featured network address and control network address in claim 7.,) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that *Ault memory are not at all used for assisting in handing a call indented for the communication terminal apparatus....*, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument regarding Nishida, that *in claim 7 there is no system to system interface sections or a need for such interface in the apparatus.*

Examiner states that in claim 7 is not mentioned that the apparatus should not have a interface. Nishida and Ault both teaches control means **configured to allocate** a network address to the recognized communication system under which the communication terminal apparatus can currently be reached and **communicating** control information via the selected base station to a

Art Unit: 2686

control network address stored in a memory (Ault, col 4 lines 9-24, Nishida col 4 lines 61-65) of the communication apparatus (Ault, column 3 lines 64-67, column 4 lines 1-15, Nishida co 7 lines 51-67, col 8 lines 1-12).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. **Any responses to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

Art Unit: 2686

(703) 308-6306, (for informal or draft communications, please label
“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, Va., sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communication from the examiner should
be directed to Melody Mehrpour whose telephone number is (703) 308-7159. The examiner can
normally be reached on Monday through Thursday (first week of bi-week) and Monday through
Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m.

NM

July 3, 2003

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
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